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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
WHIPKEY, JASON T				
ART UNIT		PAPER NUMBER		
2622				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/743,082

Applicant(s)

FURUKAWA, SHINJI

Examiner

JASON T. WHIPKEY

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 4, 2009, have been fully considered but they are not persuasive.

Regarding the independent claims, Applicant argues on page 8-9 that:

Myojo describes at paragraph 86 that related information text file 503 is intentionally kept separate from index file 502 to avoid transferring unnecessary text files. Therefore, modifying Myojo to include the claimed feature would make Myojo unsuitable for its intended purpose, which is separating text files from image files to avoid transferring unnecessary text files.

The examiner disagrees with this interpretation of Myojo.

Paragraph 86 of Myojo states (albeit in broken English):

The reference information of this index file 503 can be, however, when executing a compression process of the combinational images, described into a compressed image file, and, for instance, if the areas described with this category of information and tags thereof are previously known by the devices of both parties as in the case of performing the mutual communications using the self-company components, there is no necessity of transferring an unnecessary text file.
(emphasis added)

In other words, Myojo discloses a variation of his device that combines information in index file 503 with the compressed image file. This corresponds to the newly added limitation. (Apparently, Myojo also indicates that the tag information can be omitted completely if the receiving device is already aware of the image positions. However, this alternative feature is irrelevant to the matter at hand.)

The amended claims are still deemed obvious in view of the prior art of record.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myojo (U.S. Patent Application Publication No. 2003/0122940) in view of Hisatomi (U.S. Patent Application Publication No. 2002/0154898), Hyodo (U.S. Patent Application Publication No. 2003/0098915), and Parulski (U.S. Patent No. 5,440,401).

Regarding **claims 1, 5, and 7**, Myojo discloses an image processing apparatus (digital camera 100) to capture an object and record a captured image (see paragraphs 49-51) comprising:

a creation means (control circuit 105) for creating one composite image from an arrangement of a plurality of associated captured small images (an index image data file 502 is produced when more than one image is stored on memory card 120 and appears as shown in Figure 5C; see paragraphs 62-64);

image file creation means (control circuit 105) for creating one (the files can be combined; see paragraph 86) image file (index image data file 502 in Figure 6) including composite image data created by the creation means and management data indicating that the composite image data comprises a plurality of images (see paragraphs 62-64);

a display control means (display/switch control circuit 108) for controlling display of the composite image (on LCD 102; see paragraph 61); and

an extraction means (control circuit 105) for extracting a specified small image from the composite image whose display is controlled by the display control means (activating a replace button 404R in Figure 5D will remove — or extract — an image currently in the index image data file and replace it with another; see paragraph 62) based on the vertical size and the horizontal size of the associated captured small images (since extracting and replacing images is performed, it is inherent that the system knows the horizontal and vertical sizes of the images in the index image data file; otherwise, this task could not be performed successfully).

Myojo is silent with regard to including data describing a vertical size and a horizontal size of each of the images.

Hisatomi discloses a device that combines a number of images into an index image to be used as a menu (see Figure 23), including:

image file creation means (index image creation section 58 in Figure 15) for creating an image file (an index image; see paragraph 155) including data (a picture address table; see Figure 21 and paragraph 160) describing a vertical size and a horizontal size (X and Y dimensions; see paragraphs 161 and 168) of each of the plurality of associated captured small images in the composite image.

As suggested in paragraph 188, an advantage of including a vertical size, a horizontal size, and other data with an index image is that an image can be selected and rapidly played back by a user. Additionally, including the size of each image would yield the predictable result of

allowing the menu system to determine whether a user's click falls within the boundaries of a thumbnail image. For these reasons, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Myojo's system include the horizontal and vertical size of each image used in the composite image.

Myojo is silent with regard to the image file creation means creating an image file including manufacturer-specific information.

Hyodo discloses an image capturing apparatus (see Figure 2) that adds incidental information 230, including manufacturer-specific information (metadata), to an image file it produces (see Figure 3 and paragraph 45).

Combining the image processing apparatus disclosed by Myojo with the image processing system that includes manufacturer-specific information disclosed by Hyodo would have yielded the predictable result of creating an image file that includes more information. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Myojo's image processing apparatus include manufacturer-specific information in a created image file, as described by Hyodo.

Myojo is silent with regard to the small images placed in an adjacent arrangement.

Parulski discloses an imaging system that produces a composite image (the montage shown in Figure 7; see column 5, line 50, through column 6, line 5) such that small images are directly adjacent (see Figure 7).

Combining the system disclosed by Myojo with the adjacent, composite image-generating system disclosed by Parulski would have yielded the predictable result of maximizing the number of images that can be displayed in a given area (since no space is wasted between images). For this reason, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have Myojo's system place the small images in an adjacent arrangement.

Regarding **claims 2 and 8**, Myojo discloses:

a storage means (memory card 120) for storing the composite image created by the creation means (see paragraph 64).

Regarding **claims 3 and 9**, Myojo discloses:

a determination means for determining whether or not the specified small image is selected from the composite image whose display is controlled by the display control means, wherein, when the determination means determines that the specified small image is selected, the extraction means extracts data corresponding to the specified small image from the composite image stored in the storage means (activating a replace button 404R in Figure 5D will remove — or extract — an image currently in the index image data file selected by an operator and replace it with another; see paragraph 62).

Claim 6 can be treated like claim 1. Additionally, control circuit 105 executed a program stored in memory 105M (see paragraph 50).

Regarding **claim 11**, Hyodo discloses:

the image file creation unit (output unit 170) is configured to create the image file (see Figure 3) with manufacturer specific information including a name of the manufacturer (see paragraph 45).

Regarding **claim 12**, Hyodo discloses:

the image file creation unit (output unit 170) is configured to create the image file (see Figure 3) with manufacturer specific information including a

device name of the manufacturer (the model is added to the incidental information; see paragraph 45).

4. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myojo in view of Hisatomi, Hyodo, Parulski, and Tamura (U.S. Patent Application Publication No. 2002/0048455).

Claims 4 and 10 can be treated like claims 1 and 7, respectively. While Myojo discloses that the index files can be printed (see paragraph 133), he is silent with regard to extracting a specific image for printing.

Tamura discloses an electronic camera, including:

a print instruction means (transmitted-receiver unit 40) for transmitting a small image extracted by the extraction means to an image print apparatus (220) and instructing to start printing (selected thumbnails from an index image are sent to the printer; see paragraph 219).

Using the known technique of selecting desired images for printing from a screen on a digital camera would allow a user to conserve ink and paper, since only small reproductions of preferred images would be printed. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Myojo's system extract images for printing, as described by Tamura.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Myojo in view of Hisatomi, Hyodo, Parulski, and Cohen (U.S. Patent Application Publication No. 2005/0240627).

Claim 13 can be treated like claim 7. While Hyodo discloses that manufacturer-specific information (i.e., metadata) can be added to an image file, he is silent with regard to the information including an indication that the image file includes a plurality of images.

Cohen discloses an imaging system (see Figure 2) that produces a combined image file 500 (see Figure 7) comprised of two or more images (see paragraphs 61-62). Combined image file 500, unlike single-image files 502 and 504, has metadata for each of the images, thus indicating that the file has a plurality of images.

Combining an image processing apparatus that inserts manufacturer-specific information with an imaging system that indicates that a file has a plurality of images would have yielded the predictable result of providing more information about the resulting file's contents. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Hyodo's system include an indication that an image file includes a plurality of images, as described by Cohen.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 6 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye, can be reached at (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Whipkey/
Primary Examiner, Art Unit 2622